

REMARKS/ARGUMENTS

In the July 28, 2004 Office Action, the Examiner rejected claims: as not enabled; as indefinite; for double patenting; as anticipated; and as obvious. The Applicants respectfully traverse the Examiner's rejections and submit that any proper basis has been obviated by the present amendments; or that the rejection must be withdrawn.

The Applicants wish to thank the Examiner for the courtesy of the interview the Examiner granted to the first named Inventor and the undersigned attorney on October 6, 2004. As indicated in the Interview Summary, the first named Inventor explained:

- 1) That prior to his invention, two broad categories of keyboard support mechanisms existed. The first used articulating arms positioned separate and apart from each other and attached to the keyboard shelf at, or near the lateral side edges of the shelf. The arms were widely spaced apart. In the second type, the articulating arms were not widely spaced, rather they were attached to the keyboard shelf at, or near the center of the underside of the keyboard shelf.
- 2) This first category of mechanism is seen by U.S. Patent Nos. 4,644,875 and 5,791,263 to Watt, 5,031,867 to Cotterill and 5,302,015 to Du Vall. Some of the mechanisms described had at least one pivot point above the keyboard shelf (*e.g.*, the Watt '875 patent and the Du Vall '015 patent), and some did not (*e.g.*, the Watt '263 patent and the Cotterill '867 patent). Those that had at least one pivot point above the keyboard shelf could not be redesigned so that the attachment point of the articulating arm was

centrally positioned away from the lateral edges of the keyboard shelf in part because, the attachment bracket would plainly obstruct and prevent the keyboard from sitting on the shelf. Rather, the keyboard would have to be re-positioned above the keyboard shelf -- articulating arm attachment point which would make the modification impracticable and useless.

- 3) The second type of mechanism is exemplified by U.S. Patent Nos. 4,616,798 to Smeenge *et al.*; U.S. Patent No. 5,257,767 to McConnell; and U.S. Patent No. 4,706,919 to Soberalski *et al.* In each of the mechanisms having centrally positioned articulating arms, the articulating arms are attached at a point under the keyboard shelf.
- 4) The claimed subject matter, as set forth by claim 48, is unlike the mechanisms described in the prior art.
- 5) After the Applicants introduced to the market a commercial embodiment of their claimed subject matter (and concurrently filed their great-grand-parent application), the Applicants' invention was recognized by their peers as a notable innovation (*e.g.*, the Applicants' design was honored with a number of awards including a Silver medal at the 1997 Neocon Trade Show the U.S.'s largest contract office furniture trade show) and then repeatedly duplicated by competitors.

Indeed, many of the references cited by the Examiner, but not applied, show direct copying of the Applicants' claimed invention by competitors. Note, that the filing date of each of the patents cited by the Examiner that shows articulated arms attached to the keyboard shelf with at least one

pivot point above the keyboard shelf is after, generally more than a year after, the earliest effective filing date of the above-identified application.

Allowable Subject Matter

The Applicants also wish to acknowledge that the Examiner found that Claims 8 and 31 would be allowable if rewritten to (1) include all of the limitations of the respective base claim (as there is not any intervening claim in either instance) and (2) overcome the section 112, second paragraph rejections. In view of this finding by the Examiner, the Applicants have added new claims 101 and 102 which correspond to original claims 8 and 31. The Applicants respectfully submit that these new claims are also in condition for allowance.

Support for the Present Amendments

Claims 1, 8, 9, 15, 39, 47, 48, 50, 58, 65, 78, 79, 84, 85, 86, 88, 89, 91, 92, 95, 101 and 102 are amended (or added) herein. The Applicants respectfully submit that each of the present amendments is adequately supported by the above-identified application as originally filed. Specifically, the Applicants note:

Claim 1 was amended to restate the claim as the Applicants believe one of ordinary skill would have understood the claim before the amendment. *E.g.*, the subject matter the Examiner assumed was being claimed -- namely the sub combination. Thus, the Applicants respectfully submit that this amendment does not disclaim any subject matter. The Applicants further respectfully submit that no further showing of support is necessary.

Claim 8 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 9 was amended to explicitly state what the Applicants believed was implicitly called for by Claim 9 as originally filed. Thus, the Applicants respectfully submit that this amendment does not disclaim any subject matter. Under these circumstances, the Applicants respectfully submit that no further showing of support is necessary.

Claim 15 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 39 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 47 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 48 was amended to correct an obvious typographical error. Claim 48 was also amended to remove an unintended ambiguity in the language of this claim. The claimed subject matter, as illustrated for instance in Fig. 19, supports the auxiliary shelf away from the side edges. The Applicants respectfully submit that no further showing of support is necessary.

Claim 50 was amended to revise a formatting style. The Applicants respectfully submit that no further showing of support is necessary.

Claim 53 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 58 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 65 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 78 was amended to correct an obvious typographical error. The Applicants respectfully no showing of support is necessary.

Claim 79 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 84 was revised to better conform to the description of paragraph "056" and Figure 2. This amendment is not intended to disclaim any of the subject matter originally claimed.

Claim 85 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 86 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 88 was deleted. The Applicants respectfully no showing of support is necessary.

Claim 89 was amended to correct an obvious typographical error. The Applicants respectfully submit that submit that no further showing of support is necessary.

Claim 91 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 92 was amended to correct an obvious typographical error. Claim 92 was also amended to remove an unintended ambiguity in the language of this claim. The

claimed subject matter, as illustrated for instance in Fig. 19, supports the auxiliary shelf away from the side edges. This amendment is not intended to disclaim any of the subject matter originally claimed. The Applicants respectfully submit that no further showing of support is necessary.

Claim 95 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 98 was amended to correct an obvious typographical error. The Applicants respectfully submit that no further showing of support is necessary.

Claim 101 is original Claim 8 rewritten in independent form. The Applicants respectfully submit that no further showing of support is necessary.

Claim 102 is original Claim 31 rewritten in independent form. The Applicants respectfully submit that no further showing of support is necessary.

The Enablement Rejections

The Examiner rejected Claims 65-74, 84, 85, 87, 88, 92, 106 and 109-114 as not enabled. The Applicants point out however that rejected Claims 106 and 109-114 did not exist. Indeed, prior to the present amendment, the highest numbered claim of the application was numbered Claim 100. Thus, it appears that rejected Claims 106 and 109-114 did not and do not exist at this time. Consequently, the Applicants respectfully request that the Examiner withdraw the rejections directed to the claims identified as 106 and 109-114.

The Applicants further note that the rejection (Office communication at page 5) does not specifically mention Claims 95 and 98-100. Nevertheless, the Examiner

provided a rational for rejecting these claims. In reply, the Applicants demonstrate below why this rejection must be withdrawn.

In reply to the rejection of Claim 65, the Applicants amended that claim to obviate the rational for the rejection of that claim, and to clarify the subject matter claimed. The Applicants further respectfully submit that the amendment to Claim 65 obviates any proper basis for rejecting this claim, without disclaiming any of the subject matter originally claimed.

Claims 84, 85, and 88

The Examiner asserts claims 84 and 88 are incomprehensible and the language used inconsistent with the specification and drawings. The Applicants respectfully submit that the language of Claims 84 and 85 (Claim 88 is being cancelled in this paper) while different, is consistent with the invention described in the above-identified application.

Specifically, the Examiner has identified the following phrases:

"an elongated connection path corresponding to the pivot connection of the second linkage member to the second bracket member"

"a wedge block on the second bracket member"

"an opposed inclined surface of the wedge block supported on the second bracket member"

"said inclined surfaces slidable with respect to each other"

"said wedge member"

The Applicants have rewritten each of the above-noted phrases and respectfully submit that the claims, as rewritten, correspond to the embodiments described in

paragraph "056". The Applicants further submit that this amendment of Claims 84 and 85 was not intended to surrender any subject matter that was originally intended to be encompassed by these claims. Rather, the Applicants submit that these claims were clarified by the use of synonymous terms.

Claims 87

The Examiner alleges that there is no support in the specification or drawings for the language of Claim 87 which states: the "linkage attaches to said auxiliary shelf near the middle of said shelf". The Applicants respectfully disagree. Indeed, the Examiner acknowledges that the drawings show points of attachment of the linkage to the shelf substantially centered. Such drawings are sufficient support.

Moreover, the present rejection is a lack of enablement. *See* Page 5 of the Office Communication ("Claim[] . . . 87 . . . [is] rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.") However, the Examiner has not set forth a *prima facie* showing that one of ordinary skill could not make the device of Claim 87. In the absence of such a showing, the rejection must be withdrawn. *E.g., In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992) (The examiner "bears the initial burden . . . of presenting a *prima facie* case of unpatentability").

Claims 92

The Examiner alleges that there is no support in the specification or drawings for the language of Claim 92 which states: "attaching the linkage to the auxiliary shelf: (a) at a substantially centralized point of said auxiliary shelf". The Applicants respectfully disagree. Indeed, the Examiner acknowledges that the drawings show points of

attachment of the linkage to the shelf substantially centered. Such drawings are sufficient support.

Moreover, the present rejection is a lack of enablement. See Page 5 of the Office Communication ("Claim[] . . . 92 . . . [is] rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.") However, the Examiner has not set forth a *prima facie* showing that one of ordinary skill could not make the device of Claim 92. In the absence of such a showing, the rejection must be withdrawn. *E.g., In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992) (The examiner "bears the initial burden . . . of presenting a *prima facie* case of unpatentability").

Claims 95 and 98

The Examiner alleges that while the drawings show two side pieces (e.g., side arms 5 in Fig. 1) spaced apart by a center section (e.g., spacer 41 in Fig. 1), the drawings do not teach "slots" on opposite sides of the center section. The Applicants respectfully traverse the Examiner's position.

Specifically, the Applicants note that Fig. 1 shows a first opening 16 in each of side arms 5. The Applicants respectfully submit that one of ordinary skill would understand that each first opening 16 is a slot. Moreover, Fig. 1 shows the two first openings 16 on opposite sides of spacer 41. Thus, Fig. 1 clearly shows slots on opposite sides of the center section.

As Fig. 1 clearly shows that which the Examiner states is absent, the present rejection is not well founded and must be withdrawn.

Claims 99 – 100

The Examiner alleges that the specification does not support original claims 99 and 100 because the specification does not disclose the use of any ball bearings. The Applicants respectfully disagree.

In the first instance, Claims 99 and 100 are original claims in this application and thus each of these claims constitutes part of the disclosure of the above-identified application. For this reason alone, this rejection must be withdrawn.

Nonetheless, to more distinctly and more clearly point out the subject matter the Applicants regard as their invention, the Applicants amended Claims 99 and 100 to remove the ball bearing limitation.

The Applicants note that by deleting the ball bearing limitation, the Applicants have broadened their claims and have not surrendered any subject matter.

The Indefiniteness Rejections**Claim 1**

The Examiner rejected claim 1 as indefinite because the claim recites a desk in the preamble but indicates that the claimed subject matter is an articulating arm mechanism without the desk. However, the Examiner notes that the description of the mounting bracket, an element of the articulating arm mechanism and not part of the preamble, refers to a desk to which the mechanism might be mounted. Notwithstanding the alleged ambiguity, the Examiner understood that the claim was directed to the articulation arm mechanism. Official Communication at 7 (“the examiner will assume the *sub combination* is being claimed.” Emphasis in original).

The Examiner's allegations demonstrate that Claim 1 is sufficiently clear to satisfy the second paragraph of section 112. Thus, for this reason alone, this rejection must be withdrawn.

Nonetheless, the Applicants amended Claim 1 to further clarify that the desk is not a part of the subject matter claimed by Claim 1. Rather, Claim 1 is directed to an articulating arm mechanism that can be attached to a desk.

Claim 9

The Examiner alleges that there is no antecedent for the first side face in the second stopping means of Claim 9. The Applicants respectfully traverse the Examiner's position.

The Applicants note that Claim 9 depends from Claim 1 and Claim 1 states that a stopping means has a first side face. Consequently, the Applicants respectfully submit that a second stopping means of the type called for by Claim 1 necessarily has a first side face – if not, it would not be a second stopping means of the type called for by Claim 1.

Nonetheless, to expedite the prosecution of the above-identified application the Applicants have amended the claim to explicitly state that the second stopping means has a second first side face. With this amendment, the Applicants submit that there is more than enough antecedent for claim 9. Therefore the rejection of Claim 9 as indefinite must be withdrawn.

Claim 25

The Examiner alleges that there is no antecedent for “the fourth pivot point” in the Claim 25. The Applicants respectfully traverse the Examiner's position.

Nonetheless, to expedite the prosecution of the above-identified application the Applicants have amended the claim to delete the word "pivot" and instead merely refer to the fourth point. The Applicants believe that this amendment meets the Examiner's rejection, and note that by deleting the word "pivot" from this claim, the Applicants do not intend to narrow the claim.

Claim 85

The Examiner alleges that there is no antecedent for the phrases "the second arm", "the first arm", "said second bracket member" and "said wedge member". The Applicants respectfully traverse.

The second arm of dependent claim 85 is the second linkage arm of independent claim 84. The first arm of dependent claim 85 is the first linkage arm of independent claim 84. The second bracket member of claim 85 is the second bracket member of independent claim 84. Thus, there is sufficient antecedent for each of these limitations.

To clarify the subject matter the Applicants regard as their invention, the Applicants amended claim 84 to change the "wedge block" to an inclined surface. As indicated above, the specification and drawings as originally filed, for instance in paragraph 056, describes the inclined surface. Thus, the specification supports this limitation and claim 84 provides an antecedent for the inclined surface limitation of claim 85, as amended.

Nonetheless, to expedite the prosecution of the above-identified application the Applicants have amended the claim to expressly recite the word "linkage" in the phrases "first arm" and "second arm." The Applicants believe that this amendment meets the Examiner's rejection.

In view of the present amendments, the Applicants respectfully submit that this claim is in condition for allowance.

Claims 101 and 109-114

A) There were no claims numbered 101 or 109 – 114 in the above-identified application as examined. B) The Examiner has not provided any rationale for the rejection of these none existent claims. Consequently, the Applicants are unable to respond to the rejection of these claims.

Claims 95 and 98

As the Examiner correctly notes, the term “keyboard engaging member” improperly appears in these claims. From the context of the claim, it is clear that the phrase should have been “keyboard support member”. In view of this amendment, the Applicants respectfully submit that they have obviated any basis for the rejection of these claims under the second paragraph of section 112.

Claims 99 and 100

In view of the above-stated amendment by which the Applicants amended the phrase “ball bearing slide” to simply “slide”, the Applicants respectfully submit that the Examiner’s indefiniteness rejection based upon the phrase “ball bearing slide” is moot and should be withdrawn.

The Double Patenting Rejection

The Examiner provisionally rejected Claim 88 as double patenting over Claim 84. The Applicants have cancelled Claim 88, which the Applicants submit renders the double patenting rejection moot. The Applicants respectfully submit that in view of the cancellation of Claim 88, this rejection should be withdrawn.

The Anticipation Rejections

The Examiner rejected Claims 48, 49 and 92 as anticipated by U.S. Patent No. 5,302,015 to Du Vall. The Examiner also rejected claims 48, 83, 86, 87 and 94 as anticipated by U.S. Patent No. 4,644,875 to Watt. The Applicants respectfully traverse the Examiner's anticipation rejections.

The Du Vall Anticipation Rejection

The Examiner rejected Claims 48, 49 and 92 as anticipated by U.S. Patent No. 5,302,015 to Du Vall. *Inter alia*, the Examiner asserts that the Du Vall linkage is at a substantial centralized, interior point of the auxiliary shelf. In other words, as the Examiner points out, Du Vall discloses an auxiliary shelf mechanism in which the linkage attaches to the auxiliary shelf away from the front and rear edges, but along the side edges.

The Applicants amended their claims to more clearly point out that the subject matter they regard as their invention has its linkage away from the side edges of the auxiliary shelf. In some embodiments of the Applicants claimed subject matter the linkage attachment point may be adjacent to, for example, the rear edge of the auxiliary shelf. But unlike the Du Vall connection point, the connection point of the claimed subject matter is never along the side edges of the auxiliary shelf.

In view of this amendment, the Applicants respectfully submit that the Du Vall patent does not teach the subject matter of Claims 48, 49 nor 92. Therefore the anticipation rejection must be withdrawn.

The Watt Anticipation Rejection

As noted above, the Examiner also rejected claims 48, 83, 86, 87 and 94 as anticipated by U.S. Patent No. 4,644,875 to Watt. *Inter alia*, , the Examiner asserts that Watt teaches "connect[ing the linkage arms] to the auxiliary shelf/shelf bracket (22) away from the two side edges (see Fig. 2.) and near (defined by Merriam Webster's Collegiate Dictionary as "close to") the middle (defined by Merriam -Webster's Collegiate Dictionary as "something intermediate between extremes")" Office Communication at 10.

The Applicants respectfully submit the Examiner has misconstrued the Watt reference and that when the Watt reference is properly construed, it teaches away from the claimed subject matter. The Applicants respectfully submit that Fig. 2 is a "side elevational view". Col. 2, lines 11-16 ("Fig. 1 is a side elevational view . . . Fig. 2 is a view similar to Fig. 1" Emphasis added.) Because Fig. 2 is a side elevational view, *one cannot ascertain whether the linkage arms connect away or at the side edges.* In short, the Examiner's construction of the Watt reference is unreasonable and an abuse of discretion. The Examiner's construction of Watt is therefore not a proper basis for an anticipation rejection.

In contrast to the Examiner's contention, Fig. 3, a view taken in a plane just above the auxiliary shelf shows the teachings of Watt. In Fig. 3 it is apparent that the linkage arms (76 and 78) are attached to the shelf bracket (66) at, not away from, the side edges (64). Thus when the Watt reference is properly applied, it does not teach the subject matter of Claims 48, 83, 86, 87 and 94. Therefore the anticipation rejection based upon Watt must be withdrawn.

The Obviousness Rejections

The Examiner set forth five sets of arguments asserting that most of the claims are obvious, and thus unpatentable, under 35 U.S.C. § 103.

Specifically, the Examiner asserts that U.S. Patent No. 5,292,097 to Russell in view of U.S. Patent No. 5,257,767 to McConnell renders the subject matter of 1-7, 9-15, 17-30, 32-37, 39-47, 50-64, 89, 91, and 95-100 obvious. The Examiner then asserted that U.S. Patent No. 5,292,097 to Russell in view of U.S. Patent No. 5,257,767 to McConnell in further view of U.S. Patent No. 5,031,867 to Cotterill rendered Claims 16 and 38 obvious. The Examiner continued by asserting that U.S. Patent No. 5,292,097 to Russell in view of U.S. Patent No. 4,644,875 to Watt rendered Claim 65-69 and 73 obvious. The Examiner further asserted that U.S. Patent No. 5,292,097 to Russell in view of U.S. Patent No. 4,644,875 to Watt in further view of U.S. Patent No. 5,257,767 to McConnell rendered Claims 70-72 and 74-82 obvious. The Examiner concluded by asserting that U.S. Patent No. 4,644,875 to Watt in view of U.S. Patent No. 5,257,767 to McConnell rendered Claims 90 and 93 obvious.

The Applicants respectfully traverse the Examiner's assertions and submit that none of the cited references, alone or in any combination, render the claimed subject matter obvious under the standards of 35 U.S.C. § 103 as articulated by the BPAI and the Federal Circuit. Consequently, each of the obviousness rejections must be withdrawn.

Russell in view of McConnell

As noted above, the Examiner rejected Claims 1-7, 9-15, 17-30, 32-37, 39-47, 50-64, 89, 91, and 95-100 as obvious over Russell in view of McConnell. However, the

Applicants respectfully submit that the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious. Therefore, this rejection must be withdrawn.

In the first instance, the Examiner alleges that the device disclosed by the Russell patent is a parallelogram linkage. Office Communication at 10. In marked contrast, the Examiner recognizes that the device disclosed by the McConnell patent uses a non-parallelogram linkage. Office Communication at 12. Despite the inconsistency between these two references, the Examiner alleges one of ordinary skill would have abandoned the advantages of the Russell patent to achieve the benefits of the claimed subject matter. The Applicants respectfully submit that the Examiner's alleged motivation to combine the references is insufficient.

Specifically, Russell teaches a device that keeps the "support platform" horizontal throughout its range of motion. Specifically, Fig. 7 of the Russell patent shows the "support platform" in its raised extreme position. In that raised extreme position, the "support platform" is in a horizontal position. Fig. 1 of the Russell patent shows the "support platform" in an intermediate position. In that intermediate position, the "support platform" is in a horizontal position. Fig. 2 of the Russell patent shows the "support platform" in its lowered extreme position. In that lowered extreme position, the "support platform" is in a horizontal position. In sum, the Russell patent teaches that the "support platform" is kept horizontal.

This constant horizontal position of the Russell patent "support platform" was known to be a desirable attribute of such devices because it reduced the probability that

the keyboard would fall off of the platform during operation of the mechanism. See U.S. Patent No. 4,616,798 to Smeenge *et al.* col. 5, lines 34 – 44.

In marked contrast to the constant horizontal position of the Russell patent support platform, the device of the McConnell patent changes the orientation of the platform as the platform is raised or lowered. *E.g., compare* Fig. 2 of the McConnell patent *with* its Fig. 3. In addition to problems due to sliding and/or falling keyboards, because of its adjustment of the support platform, the device of the McConnell patent may not be useful for some users at some positions other than the fully raised position. For instance, a person may wish to use the device at the height of the fully lowered device; however, because of the angled position of the support platform in that lowered position, the keyboard on a McConnell type device becomes largely unusable in the fully lowered device. This disadvantage – *i.e., motivation to avoid* -- of the McConnell device was not considered by the Examiner. However, the disadvantage fully negates any motivation to combine the Russell and McConnell references. Therefore, for this reason alone, the present rejection is improper and must be withdrawn.

Additionally, the Applicants note that at the time the Applicants made their invention, those of ordinary skill knew that the device described by McConnell in either its retracted or extended positions, *see e.g.* Fig. 2, was an obstacle. Either the knee hole space was restricted when the mechanism was retracted or, when extended a person's knees and clothing were scraped and the mechanism a hindrance. It was a device to be avoided and not emulated. The Applicants note that the Examiner did not consider this further disadvantage of the device disclosed by McConnell. Consequently, for this further reason, those of ordinary skill were not motivated to combine the Russell and

McConnell references. Thus, for this further reason, alone or in combination with the above-stated reason, the present rejection is improper and must be withdrawn.

The Applicants further note that neither the Russell patent nor the McConnell patent provides any guidance as to what parts to pick of the other to combine to make the claimed subject matter. Instead, the Examiner has relied upon the road map provided by the rejected claims. That however is hindsight, which is an improper basis for a rejection under 35 U.S.C. § 103.

Furthermore, the Applicants note that the Examiner's proposed modification of the device of the Russell patent, making the parallelogram linkage a non-parallelogram linkage, renders the device of the Russell patent not suitable for its intended purpose —

supporting a support platform for movement
relative to a base in a generally parallel orientation
through a plurality of positions.

Abstract of the Russell patent (emphasis added).

Moreover, if the modification of the primary reference, Russell, renders the device unable to perform its intended function as it would here, namely of maintaining the horizontal position of the support platform, then combining it with the modifying reference, McConnell, that teaches away from the primary reference cannot be the basis of a *prima facie* showing of obviousness under 35 U.S.C. § 103. *E.g., Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 U.S.P.Q.2d 1294 (Fed. Cir. 1999). For this further reasoning, the present rejection is improper and must be withdrawn.

Furthermore, while the Examiner is correct some of the embodiments of the Russell patent have "a lower link/bar/side arm (15)", the Examiner ignores the

embodiments of Russell Figs. 1 – 10 that do not have a lower link of the type shown in Figs. 20 -21. Moreover, the Examiner has not articulated any reason why one of ordinary skill would have selected only the latter embodiments shown in Russell. This lack of a teaching to choose the appropriate teaching of Russell illustrates the hindsight nature of the present rejection. As a result, the present rejection is improper and must be withdrawn.

The Applicants also note that the Examiner has not identified any teaching or suggestion to combine the McConnell patent with the Russell patent. Rather, the Examiner states that because both patents relate to support mechanisms and have different benefits one would have scrambled their parts to arrive at the claimed subject matter. Office Communication at 13 (“It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the articulating arm mechanism of Russell by substituting the shelf bracket of McConnell for the shelf bracket (14) of Russell and providing a non-parallelogram linkage because one would have been motivated to provide for effective clockwise movement of the shelf bracket as the linkage is moved to a storage position as taught by McConnell . . .”) Such a generalized motivation is insufficient. *See In re Rouffet*, 149 F3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Moreover, the Examiner fails to consider all the impediments that the McConnell and Russell mechanisms exhibit.

Because the Examiner has not shown any specific teaching or suggestion to combine, the present rejection is improper and must be withdrawn.

For each of the above-stated reasons, and others, the Examiner has not established a *prima facie* showing that the Russell patent can be combined – under the standard of 35

U.S.C. § 103 -- with the McConnell patent to arrive at the claimed subject matter. In other words, the present rejection is improper and must be withdrawn.

Russell in view of McConnell in further view of Cotterill

As noted above, the Examiner rejected Claims 16 and 38 as obvious over Russell in view of McConnell in further view of Cotterill.

The Applicants respectfully submit that the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious. Therefore, this rejection must be withdrawn.

In the first instance, this rejection compounds the problems addressed above by adding a further inconsistent reference. Thus, for each of the reasons stated above, this rejection is improper and must be withdrawn.

The Examiner alleges that the McConnell reference teaches "means for adjusting the linkage and to facilitate adjustment to a desired angle and tilt with only one hand" Office Communication at 15. However, the support the Examiner cites for that proposition does not say what the Examiner asserts. Rather, the text the Examiner cites states:

Another object of the invention is to provide an improved keyboard platform support mechanism which includes an easily adjustable mechanism for altering the angle or tilt of the platform, and which also includes an easily adjustable and accessible mechanism for locking or holding the support linkage in a fixed position.

McConnell patent at col. 2, lines 42-50.

There is no mention of being able to adjust anything with one hand in that paragraph, or anywhere else in the McConnell patent. In other words, the Examiner has misconstrued the McConnell patent. For this reason alone, the Examiner has not set forth a *prima facie* showing that the claimed subject matter is obvious. Therefore the rejection must be withdrawn.

Moreover, while Cotterill has an elongate member with a longitudinal slot, the Applicants note that Cotterill's slot is located next to the auxiliary shelf bracket. *E.g.*, Cotterill's Fig. 1. In contrast, in those embodiments of Russell that have a slot, the slot is located away from the auxiliary shelf bracket. *E.g.*, Russell's Fig. 20. Furthermore, McConnell does not have a slot. In view of these mutually exclusive embodiments, how are these references to be combined? The Examiner has not shown any teaching that would guide one of ordinary skill, other than the rejected claims. That, again, is hindsight and is not an appropriate basis for rejecting the present claims. Therefore for this reason alone, the present rejection must be withdrawn.

Furthermore, while each of the references has four elongated members, Russell and McConnell each teach two elongated members on each side. In marked contrast, Cotterill has three elongated members on one side and one on the other side. If these references are combined, does the device have two elongated members on each side, three elongated members on one side and one on the other side, or some other combination? This question establishes that the cited art does not teach any combination of these references. Therefore, the rejection is improper and must be withdrawn.

For each of the above-stated reasons, and others, the Examiner has not established a *prima facie* showing that the Russell patent can be combined – under the standard of 35

U.S.C. § 103 – with the McConnell and Cotterill patents to arrive at the claimed subject matter. In other words, the present rejection is improper and must be withdrawn.

Russell in view of Watt

As noted above, the Examiner rejected Claims 65-69 and 73 as obvious over Russell in view of Watt.

The Applicants respectfully submit that the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious. Therefore, this rejection must be withdrawn.

The Examiner acknowledges that the Russell patent “does not teach the shelf bracket (14) being pivotally connected to the front portion of the first/upper arm (16) by at least one pivot positioned above a shelving surface (at 14)”. Office Communication at 15. However, the Examiner asserts that Watt teaches a pivot connection above the shelving surface. *Id.* Therefore, the Examiner concludes “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the articulating arm mechanism of Russell by providing a pivot connection between the first/upper arm and the shelf bracket located above the shelving surface as an alternative means for pivotally supporting the shelf bracket and as taught by Watt.” *Id.* In other words, the Examiner is offering another serving of scrambled references.

However, the Examiner has not articulated any rational why one of ordinary skill would have made such a modification of the Russell patent. Nor has the Examiner identified which of the nine embodiments of the Russell patent the ordinarily skilled artisan would have chosen to modify in this manner. Rather, once again, the rejection

feels like hindsight where the rejected claims are the only road map for arriving at the claimed subject matter.

But as noted above, use of the rejected claims to guide the combination of elements to arrive at the claimed subject matter does not constitute a *prima facie* showing of obviousness.

Because the Examiner has not identified any objective teaching that would have lead one of ordinary skill to combine any embodiment of Russell with Watt, this rejection is improper and must be withdrawn.

Russell in view of Watt in further view of McConnell

As noted above, the Examiner rejected Claims 70-72 and 74-82 as obvious over Russell in view of Watt in further view of McConnell.

The Applicants respectfully submit that the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious. Therefore, this rejection must be withdrawn.

In addition to the fundamental problems of combining Russell with Watt mentioned above, the addition of the McConnell patent further renders the combination untenable. For instance, as the Examiner noted, McConnell rotates his shelf bracket when he lowers his device. Office Communication at 13 and 16. By rotating the shelf bracket, McConnell increases the distance between the height (from the floor) of the front end of the keyboard platform and the bottom of the shelf bracket. If one were to rotate the shelf bracket of Watt in this fashion, it is not clear that the rotated bracket and shelf platform would fit within storage box 12 (shown in Fig. 1 of Watt). In other words, the cited references are inconsistent and cannot be combined under the standard of 35 U.S.C.

§ 103 to support a rejection. Therefore the present rejection is improper and must be withdrawn.

Furthermore, the Examiner alleges that one of ordinary skill would add a swivel mechanism (ala McConnell) to the structure formed by scrambling Russell with Watt. The Applicants respectfully submit that while the device of McConnell can accommodate such a swivel mechanism, the device of Watt probably may not. Rather, if Watt were swiveled, the Applicants submit it would produce a substantial torque component that could break the mechanism. In other words, there is a substantial likelihood that the combination advocated by the Examiner would not be successful in its intended purpose. For this further reason, the present rejection is improper and must be withdrawn.

Watt in view of McConnell

As noted above, the Examiner rejected Claims 90 and 93 as obvious over Watt in view of McConnell.

The Applicants respectfully submit that the Examiner has not set forth a *prima facie* showing that the subject matter of these claims is obvious. Therefore, this rejection must be withdrawn.

This set of scrambled references combines the parallelogram linkages of Watt (e.g., col. 3, lines 64-67) with the non-parallelogram linkage of McConnell. As noted above, parallelogram linkages provide for a constant positioning of the platform whereas the non-parallelogram linkage of McConnell rotates the platform as it is raised or lowered. Thus, for this reason alone, the two references are inconsistent and cannot be

combined to form a proper basis for a rejection of the claimed subject matter as obvious. Therefore, this rejection must be withdrawn.

The Applicants also note that McConnell discloses the use of cross-plate 62. *E.g.*, Fig. 6. Those of ordinary skill in the art know that articulated arm mechanisms with a cross-plate generally are relatively narrow – *i.e.*, the arm attaches to the shelf bracket away from the lateral edges of the keyboard platform. See U.S. Patent No. 4,616,798 to Smeenge *et al.* In marked contrast, the shelf bracket of the Watt device attaches to the articulated arms at the lateral edges of the keyboard platform. Fig. 3. Thus, the disclosure of these references is inconsistent as to the width of the shelf bracket and where the articulating arm attaches to the shelf bracket.

However, none of the cited references provides one of ordinary skill with guidance as to what part(s) of Watt should be scrambled with what part(s) of McConnell. Rather, the only road map for picking non-parallelogram arms and a narrow shelf bracket with articulating arms attaching to the shelf bracket away from the lateral edges of the keyboard being the rejected claims. That is hindsight and not a proper basis for rejecting the claim as obvious. Therefore the present rejection must be withdrawn.

CONCLUSION

In view of the above amendments and remarks, the Applicants respectfully submit that they have obviated any reasonable basis for any of the rejections set forth in the Office Action of July 28, 2004. The Applicants therefore respectfully submit that the pending claims are in condition for allowance and respectfully solicit the same at an early date.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

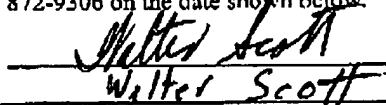


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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (703) 872-9306 on the date shown below.


Walter Scott

October 13, 2004
Date